

EXAMINATION OF APPLICATIONS

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718 Affidavit or Declaration to Disqualify Commonly Owned Patent as Prior Art, 37 CFR 1.130

37 CFR 1.130. Affidavit or declaration to disqualify commonly owned patent or published application as prior art.

(a) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 on a U.S. patent or U.S. patent application publication which is not prior art under 35 U.S.C. 102(b), and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent or published application are not identical but are not patentably distinct, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqualify the patent or patent application publication as prior art. The patent or patent application publication can be disqualified as prior art by submission of:

(1) A terminal disclaimer in accordance with § 1.321(c); and

(2) An oath or declaration stating that the application or patent under reexamination and patent or published application are currently owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104.

(b) When an application or a patent under reexamination claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application or a patent under reexamination. A judicially created double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(c).

See MPEP § 804.03 and § 706.02(1) through § 706.02(1)(3) for subject matter disqualified as prior art under 35 U.S.C. 103(c) where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

37 CFR 1.130(a) addresses those situations in which the rejection in an application or patent under reexamination to be overcome is a rejection under 35 U.S.C. 103 in view of a U.S. patent or U.S. patent application publication due to the requirement in 37 CFR 1.131 that any U.S. patent or U.S. patent application publication to be antedated not claim the same patentable invention (as defined in 37 CFR 1.601(n)) as the application or patent under reexamination. The applicant or patent owner is also prevented from proceeding in an interference due to the provision in 37 CFR 1.602(a) that an interference will not normally be declared or continued between appli-

cations owned by a single party, or an application and an unexpired patent owned by a single party.

As 37 CFR 1.130(a) addresses those situations in which the inventions defined by the claims in the application or patent under reexamination and by the claims in the U.S. patent or patent application publication are not patentably distinct, 37 CFR 1.130(a)(1) requires a terminal disclaimer in accordance with 37 CFR 1.321(c), and 37 CFR 1.130(a)(2) requires an oath or declaration stating, *inter alia*, that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104. The inventor named in the application or patent under reexamination must have invented the claimed subject matter before the actual date of invention of the subject matter of the reference claims. The affidavit or declaration may be signed by the inventor(s), the attorney or agent of record, or assignee(s) of the entire interest.

The phrase "prior inventor under 35 U.S.C. 104" requires that the inventor named in the application or patent be the prior inventor within the meaning of 35 U.S.C. 104, in that an applicant or patent owner may not:

(A) establish a date of invention in a foreign country other than a NAFTA or WTO member country;

(B) establish a date of invention in a WTO member country other than a NAFTA country earlier than January 1, 1996; or

(C) establish a date of invention in a NAFTA country other than the U.S. earlier than December 8, 1993.

37 CFR 1.130(b) provides that when an application or a patent under reexamination claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application or a patent under reexamination. A judicially created double patenting rejection may be obviated by filing a terminal disclaimer in accordance with 37 CFR 1.321(c). See MPEP § 804.02.

A U.S. patent or U.S. patent application publication that anticipates the claimed subject matter cannot be disqualified as prior art under 35 U.S.C. 103(c) or 37 CFR 1.130 or 1.131.